

U.S. Serial No. 09/532,755  
Attorney Docket No. PD-990193

### REMARKS

Claims 11-14, 16-19, 26-43, 45, 46, 49-52 and 59-64 are pending and at issue in the above-referenced patent application. Of the claims at issue, claims 14, 26, 45, 49 and 59 are independent. In the Office action dated February 3, 2003, claims 6, 7, 14, 15, 48 and 49 were objected to but indicated as allowable if rewritten in independent form. In the response to the Office action dated February 3, 2003, claims 1, 3-5, 7-14, 16-19, 26, 45 and 49 were amended with claims 14 and 49 rewritten in independent form, claims 2, 6, 15, 20-25, 44, 47 and 48 were canceled without prejudice, and claims 53-58 were added. In the Office action dated August 1, 2003, claims 1, 3, 4, 7-10, 13, 16 and 53-58 were rejected as anticipated by Knee et al. (U.S. 2002/0095676 A1), claims 5, 11, 12, 17-19, 26-43 and 49-52 were rejected as obvious over Knee et al. in view of one or more Berezowski et al. (U.S. Patent No. 6,064,376), Davis et al. (U.S. Patent No. 5,559,548), Picco et al. (U.S. Patent No. 6,029,045), Sawyer (U.S. Patent No. 6,084,628), Ward et al. (U.S. 2002/0073424 A1), Pollack (U.S. Patent No. 5,153,580), and Buch et al. (U.S. Patent No. 6,463,468), and claims 45 and 46 were rejected as obvious over Picco et al in view of Knee et al. Claim 14 was not rejected. By way of this amendment, claims 11-13, 16-19 and 50 have been amended, claims 1-10 have been canceled without prejudice, and claims 59-64 have been added. The foregoing rejections are respectfully traversed and reconsideration is respectfully requested.

Independent claim 14 and claims 11-13 and 16-19 dependent directly or indirectly thereon clearly recite, *inter alia*, storing advertisements having a similarity score greater than a predetermined threshold similarity score and discarding advertisements having a similarity score less than or equal to the predetermined threshold similarity score. No such operations are disclosed or suggested by any of the cited references. In particular, Knee et al. fails to disclose or suggest storing advertisements having a similarity score greater than a

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predetermined threshold similarity score and discarding advertisements having a similarity score less than or equal to the predetermined threshold similarity score. While Knee et al. discloses a program guide system that uses demographic category values based on information obtained from a user's interaction and categorized into demographic categories, the disclosed system of Knee et al. does not store advertisements having a similarity score greater than a predetermined threshold similarity score and discard advertisements having a similarity score less than or equal to the predetermined threshold similarity score as recited by claim 14. Accordingly, Knee et al. fails to anticipate pending claims 11-14 and 16-19. The remaining references do not overcome the deficiency of Knee et al. Thus, the applicants respectfully submit that because each of the cited references fails to disclose each and every element of claims 11-14 and 16-19, these claims are not anticipated thereby.<sup>1</sup>

Independent claim 26 and claims 27-43 dependent directly or indirectly thereon clearly recite, *inter alia*, the use of statistical information representing the number of times that advertisements are displayed. No such operation is taught or suggested in the cited references. Neither Knee et al. nor Ward et al. discloses or suggests the use of statistical information representing the number of times that advertisements are displayed. Because neither Knee et al. nor Ward et al. makes such a disclosure, no combination of these references, even if there were motivation for such a combination, can result in the claimed system.

In particular, it was acknowledged in the Office action dated August 1, 2003 that Knee et al. fails to disclose the use of statistical information representing the number of times that advertisements are displayed. While Ward et al. discloses a counter to keep track of

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<sup>1</sup> "Anticipation under 35 USC § 102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention." *Rockwell Int'l Corp. v. United States*, 47 USPQ2d 1027 (Fed. Cir. 1998).

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access to a page and/or section, Ward et al. does not disclose or suggest use of statistical information representing the number of times that advertisements are displayed. Rather, Ward et al. merely discloses a priority counter that is page dependent so that advertisements are displayed in a pre-determined sequence when a particular page is view multiple times. That is, a first ad is displayed on a particular page (e.g., page "X") when that particular page (i.e., page "X") is viewed for the first time, a second ad is displayed when the same page (i.e., page "X") viewed is for the second time, a third ad is displayed when the same page (i.e., page "X") is viewed for the third time, and so on. *See, e.g.,* Ward et al., paragraph [0282]. Further, the system disclosed in Ward et al. displays the first ad again when another page (e.g., page "Y") is displayed for the first time, displays the second ad is displayed when the same page (i.e., page "Y") is viewed for the second time, displays the third ad when the same page (i.e., page "Y") is viewed for the third time, and so on. Ward et al. does not, however, disclose or suggest any need or advantage to keep track of the number of times that advertisements are displayed.

The remaining obviousness rejections of claims dependent directly or indirectly on independent claim 26 are based on references even further removed from the subject at hand. Pollack is directed to a device providing a sleep timer that automatically turns off the timer and restarts it in response to receipt of a transmission from a remote control transmitter unit. Buch et al. is directed to a system that simply discards the oldest ad from an ad pool when a new ad is received without considering any attributes of the ads. Berezowski et al. is directed to an adjustable program guide display system that adjusts the relative sizes of promotional information and program listing regions without considering any attributes of the ads. It is respectfully submitted that Pollack, Buch et al., and Berezowski et al. fail to disclose or

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suggest the use of statistical information representing the number of times that advertisements are displayed. Accordingly, the obviousness rejections based thereon should be withdrawn.

It is well established that the prior art must teach or suggest each of the claim elements and must additionally provide a suggestion of, or an incentive for, the claimed combination of elements to establish a *prima facie* case of obviousness. See *In re Oetiker*, 24 U.S.P.Q. 2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985); *In re Royka*, 490 F.2d 981 (CCPA 1974) and M.P.E.P. § 2143. Because none of the cited references discloses or suggests the use of a similarity score for each of the plurality of advertisements received based on a correlation between attributes associated with each of the plurality of advertisements and attributes associated with the selection history and the use of statistical information representing the number of times that advertisements are displayed, it follows that no combination of these references renders claims 26-43 obvious.

The general principle that the prior art must teach or suggest each claim element and provide a suggestion or modification for the claimed combination holds true even if the applied art could be modified to produce the claimed invention. See *In re Mills*, 16 U.S.P.Q. 1430, 1432 (Fed. Cir. 1990); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."). Because none of the applied references discloses or suggests the desirability of using of statistical information representing the number of times that advertisements are displayed, as recited in the claims at issue, there is no motivation for the modifications that the examiner suggests.

In order for the references to provide such a suggestion, the advantage of providing such feedback to broadcast providers and/or advertisers regarding advertisements must first be recognized. For example, broadcast providers and/or advertisers may be provided with the

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number of times that a particular advertisement is displayed to a particular viewer. *See, e.g.*, U.S. Patent Application Serial No. 09/523,755, page 28, line 25 – page 29, line 25. However, the cited references are silent in this regard. As evidence attesting to the scope of the problem solved by the inventors, the applicants note the need to determine the effectiveness of advertisements and to more precisely price advertisements by knowing the number of times that an advertisement is displayed. *See, e.g.*, U.S. Patent Application Serial No. 09/523,755, page 29, lines 16 - 18. Such a problem has remained unsolved and clearly not obviated by Knee et al., Ward et al., Pollack, Buch et al., and Berezowski et al. The applicants therefore respectfully submit that the obviousness rejections in light of Knee et al. in view of one or more of Ward et al., Pollack, Buch et al., and Berezowski et al. should be withdrawn.

It was acknowledged in the Office action dated August 1, 2003 that both Knee et al. and Picco et al. failed to disclose storing ads with the highest similarity score when the ads exceeds the maximum number of ads stored. The examiner merely relies on Official Notice by stating that “storing relevant information when there is no more memory is notoriously well known in the art.” See page 14 of Office action dated August 1, 2003. The applicants respectfully submit that the examiner’s conclusory statement amounts to nothing more than stating “It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Picco in view of Knee to have the system store only relevant ads when memory exceeds a maximum number of ads in order to utilize memory space by storing relevant ads.” See pages 14-15 of Office action dated August 1, 2003. Of course, such circular reasoning (i.e., add “X” to have the benefit of “X”) cannot be a legally proper tool for identifying a suggestion for combining references because no combination of old elements would ever be patentable as one could always nakedly state, a person would be

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motivated to add old element X from one reference to another reference because adding element X offers an advantage. Simply put, there is always an advantage to combining old elements that can be identified through hindsight once that combination is known.

It should be quite clear from the above that merely identifying an advantage for adding an old element to a combination of elements is not a proper suggestion for making that combination. The MPEP further proves this point. In particular, MPEP § 2144 states that "the strongest rationale for combining references is a recognition . . . in the prior art or . . . based on established scientific principles or legal precedent, that some advantage would have been produced by their combination."<sup>2</sup> Further, the Federal Circuit has stated that there can be no obviousness ruling unless something in the prior art suggests an advantage to combining the references. The advantage itself is not the suggestion, rather the Court makes it clear that something in the prior art must suggest the advantage.

The applicants respectfully submit that the examiner has failed to recognize this point. Rather than looking for something in the art that suggests an advantage to making the combination, he just looks for the advantage itself and mislabels that advantage as "suggestion." As explained above, this is a literal elimination of the suggestion requirement. Because there is always an advantage to a claimed element, the examiner's misplaced view of an advantage as the suggestion inherently renders all combinations of old elements unpatentable precisely because such reasoning eliminates the suggestion requirement from the analysis. Clearly, neither the MPEP section noted above nor the *Sernaker* case upon

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<sup>2</sup> "[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings." *In re Sernaker*, 702 F.2d 989, 995-96 (Fed. Cir. 1983)

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which the MPEP section rests for authority stands for the proposition that an advantage of an element is a suggestion in and of itself for including that element in a combination.<sup>3</sup>

While it is true that one possible advantage is storing relevant when there is no more memory, that is not a suggestion in and of itself for storing advertisements from the plurality of advertisements having the highest similarity scores in Picco et al. and/or Knee et al.<sup>4</sup> Here, the examiner has failed to identify any prior art suggestion of desirability of the modification. The examiner merely relies on Official Notice to suggest that "storing relevant information when there is no more memory" to modify Picco et al. and/or Knee et al. would result in storing advertisements from the plurality of advertisements having the highest similarity scores.

Applicants note that they do not accept any of the Official Notice made in the Office action as a valid basis for rejecting any pending claims. Frankly, the use of Official Notice to supply missing elements in references to reject claims reduces patent examination from a factual inquiry into the state of the prior art, to an exercise in conjecture and personal opinion. Such an approach is indisputably improper. Accordingly, applicants accept none of the rejections based on Official Notice and hereby reiterate their previous request for withdrawal of all rejections based on such Official Notice or a sworn affidavit specifying any and all facts within the examiner's personal knowledge supporting any such Official Notice assertion as expressly required by MPEP § 2144.03.

Applicants respectfully traverse the Official Notice taken by the examiner. It is beyond dispute that claim rejections cannot be entirely based on Official Notice. As

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<sup>3</sup> Supra note 1.

<sup>4</sup> "The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Frisch*, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992).

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explained by the MPEP, "The Examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art." MPEP § 2144.03 (emphasis added). However,

"The facts so noticed serve "to fill the gaps" which might exist  
in the evidentiary showing" and should not comprise the  
principal evidence upon which a rejection is based.

MPEP § 2144.03, quoting, *In re Ahlert*, 165 U.S.P.Q. 418, 420-421 (CCPA 1970) (emphasis added). Here, the Official Notice serves as the principal "evidence" for the rejections of claims 45 and 46. Therefore, the rejection of claims 45 and 46 is improper as a matter of law and must be withdrawn.

Finally, the MPEP states:

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner.

MPEP § 2144.03 (emphasis added). As the rejections of claims 45 and 46 appear to be based on nothing more than alleged personal knowledge of the examiner, applicants hereby respectfully request the examiner to withdraw the Official Notice or to provide the applicants with a suitable affidavit explaining in detail the basis for his opinion as required by MPEP § 2144.03.

Independent claim 49, and claims 50-52 dependent directly or indirectly thereon, clearly recite, *inter alia*, the use of a predetermined lifetime which identifies a time for a controller to discard an advertisement from a memory and to retain those advertisements with a similarity score higher than a cutoff similarity score beyond the predetermined lifetime. No such structure is taught or suggested in the cited references. Neither Picco et al. nor Knee et



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al. discloses or suggests the use of a predetermined lifetime which identifies a time for a controller to discard an advertisement from a memory and to retain those advertisements with a similarity score higher than a cutoff similarity score beyond the predetermined lifetime. Because none of the cited references makes such a disclosure, no combination of these references, even if there were motivation for such a combination, can result in the claimed system.

While Picco et al. discloses a system to pieces of local content in a memory that match the predetermined criteria stored in a set-top box, Picco et al. does not disclose or suggest the use of a predetermined lifetime which identifies a time for a controller to discard an advertisement from a memory and to retain those advertisements with a similarity score higher than a cutoff similarity score beyond the predetermined lifetime.

The remaining obviousness rejections of claims dependent directly or indirectly on independent claim 49 are based on a reference even further removed from the subject at hand. Sawyer is directed to a system that provides targeted advertising to subscribers utilizing display screens to conduct a video telephone call. Even assuming *arguendo*, that Sawyer discloses such features, it is respectfully submitted that they fail to disclose or suggest the use of a predetermined lifetime which identifies a time for a controller to discard an advertisement from a memory and to retain those advertisements with a similarity score higher than a cutoff similarity score beyond the predetermined lifetime. Accordingly, the obviousness rejections based thereon should be withdrawn.

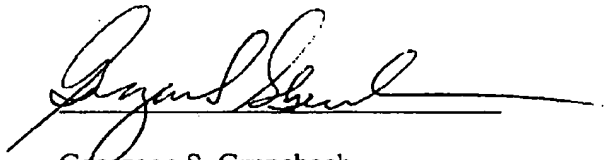
For at least the foregoing reasons, it is respectfully submitted that claims 11-14, 16-19, 26-43, 45, 46, 49-52 and 59-64 are in condition for allowance. If, for any reason, the examiner is unable to allow the application in the next Official action, the examiner is

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encouraged to telephone the undersigned attorney at the telephone number listed below to  
discuss this matter.

Respectfully submitted,

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